

## **REMARKS**

### **SUMMARY**

Reconsideration of the application is respectfully requested.

Claims 1-24 are now in the application. Claims 1-24 have been rejected by the Examiner.

Applicants appreciate the acknowledgement of Applicants' Information Disclosure Statements filed June 6, 2005, and July 5, 2005, as well as the Examiner's consideration of Applicants' arguments and 37 C.F.R. §1.131 affidavit filed June 30, 2005.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

In "Claim Rejections – 35 USC § 102" item 6 on page 5 of the above-identified Office Action, claims 1-24 have been rejected as being fully anticipated by U.S. Patent Application Publication No. 2002/0100036 A1 to *Moshir, et al.* (hereinafter "Moshir") under 35 U.S.C. § 102(e). Applicants respectfully traverse.

### **AVAILABILITY OF MOSHIR**

While the Examiner's "Response to Arguments" item 4 on pages 2-4 of the above-identified final Office Action is appreciated, Applicants renew their respectful submission that Moshir is not available as a prior art reference against the present invention as claimed in claims 1-24.

As Applicants stated in their response of June 30, 2005, Moshir was filed on September 20, 2001, about eight months after the instant application. However, Moshir also

claims the priority of Provisional Application No. 60/234,680, originally filed September 22, 2000, under 35 U.S.C. § 119(e), less than about four months before the instant application was filed. Accordingly, Moshir must find support for each of the portions referenced in the above-identified Office Action in Provisional Application No. 60/234,680.

Even assuming, *arguendo*, that the cited portions of Moshir are properly supported, in response, Applicants' submission of a 37 C.F.R. § 1.131 affidavit, supported by corroborating evidence, on June 30, 2005 has established a "reduction to practice" by Applicants prior to September 22, 2000. Enclosed as corroborating evidence was a summary of available new features the patent attorney received from the inventors in the document entitled "Update Service v1.5 Feature List" created by Geoffrey K. Bauman, one of the Inventors, and dated July 18, 2000. Applicants respectfully note that the previously-identified document includes features from both version 1.1 and version 1.5 of the Update Service and that those features of version 1.5 were the new features being explained in the July 18, 2000, document.

In the Examiner's "Response to Argument" section, in item 4(a) on page 2, the Examiner sustained the rejection made in the prior March 31, 2005, Office Action because Applicants provided corroborating evidence that antedated the Moshir reference by two months and four days. The Examiner suggested that this time period is insufficient to overcome a rejection because Moshir could equally submit an affidavit under 37 C.F.R. § 1.131 antedating Applicants' date of July 18, 2000. Applicants respectfully suggest that Moshir's ability to antedate Applicants' July 18, 2000 date is not relevant under MPEP 715. MPEP 715 states that, in an *ex parte* proceeding such as this, the relevant date that an applicant submitting a 37 C.F.R. § 1.131 must swear behind is the prior art date of the

reference under 35 U.S.C. § 102(e). Moshir's prior art date under § 102(e) is September 22, 2000. Any affidavit under § 1.131 accompanied by sufficient corroborating evidence establishing a date prior to September 22, 2000, then would be sufficient to overcome a rejection under Moshir. Accordingly, Applicants renew their submission that Moshir is unavailable.

Additionally, in the Examiner's "Response to Argument" section, in item 4(b) on pages 3-4, the Examiner gives as an additional reason for sustaining the above-mentioned rejection the insufficiency of the corroborating evidence supporting Applicants' affidavit. Applicants respectfully submit, contrary to the Examiner's suggestion, that the features claimed in claims 1-24 are specifically described by "Update Service v1.5 Feature List."

Claim 1, for example, requires that a server "accept[] check in by a client computer at a first point in time to determine if the client computer's software needs to be updated." This operation is fully supported by ¶ 1 on page 2 of the "Update Service v1.5 Feature List," which provides that "[a]fter its initial install, [the client] checks into the Update server and checks for newer versions . . . ."

Claim 1 further requires that a server "provid[e] the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, if it is determined that the client computer's software is to be updated." The "update task list," though not explicitly referenced, is sufficiently contained by inference within the "Update Service v1.5 Feature List." Any reply from a server indicating that more than one update should be downloaded would satisfy the requirement that the server provide the client computer with an

update task list. Such a reply is disclosed in ¶ 5 on page 3 of the document, where a client signs up for updates to some category of test applications, and when the test applications become available, a client checking in is notified of them and updated to them.

The asynchronous performance of update tasks at a later time or times is also disclosed at least on ¶ 5 on page 2 of the document, which provides for completion at a later time of an installation, if the installation requires the replacement of a file that is in use at the time of installation.

Accordingly, Moshir is believed to be unavailable as a prior art reference against the present invention, as claimed.

In view of the foregoing, the Examiner is requested to withdraw the rejections under 35 U.S.C. § 102(e) in item 6 on page 5 of “Claim Rejections – 35 USC § 102” of the above-identified final Office Action and issue a Notice of Allowance.

#### **APPLICABILITY OF MOSHIR**

Even if the corroborating evidence of Applicants’ 37 C.F.R. §1.131 is assumed, for the sake of argument, insufficient (a point which Applicants do not concede), Moshir still fails to teach or disclose the present invention, as claimed in claim 1, in as complete detail as is recited in claim 1.

Claim 1 calls for, *inter alia*, in a server, a method of operation comprising:  
accepting check in by a client computer at a first point in time to determine if the  
client computer’s software needs to be updated; and

providing the client computer with an update task list listing one or more tasks to be performed by the client computer **asynchronously at a later point or later points in time** to update the client computer's software, if it is determined that the client computer's software is to be updated.

Moshir teaches a method of "discovering software updates, discovering if a given computer can use the software update, and then updating the computers with the software as needed automatically across a network without storing the updates on an intermediate machine within the network." The process is facilitated by an update agent executing on the target computers (the computers to be updated). The update agent contacts an update server to retrieve from the server a list of update tasks the target computer needs to perform. Upon retrieving a list, the agent begins to automatically download the needed update.

In contrast, the present invention, as claimed in claim 1, recites performing the update "asynchronously, at a later point or later points in time." Nothing in Moshir teaches or even hints at asynchronous or delayed performance of update tasks by the client computer. The only delays referenced in Moshir are delays by the server in performing its functions (Moshir ¶¶ 61-62). The target computer of Moshir, through its update agent, is not shown to perform the update tasks provided to it "asynchronously, at a later point or later points in time." Thus, Moshir fails to disclose, in as complete detail as is claimed in claim 1, performing the update "asynchronously, at a later point or later points in time."

Accordingly, claim 1 is clearly patentable over Moshir.

Claim 13 recites an apparatus performing the operations recited in claim 1. Thus, for at least the same reasons, claim 13 is patentable over Moshir.

Claims 2-12 and 14-24 are directed toward methods and apparatuses of claims 1 and 13, incorporating their limitations respectively. Thus, for at least the same reasons, claims 2-12 and 14-24 are patentable over Moshir.

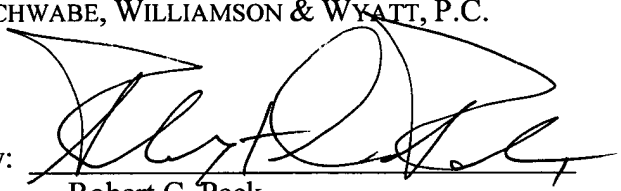
**CONCLUSION**

In view of the foregoing, reconsideration and allowance of claims 1-24 are solicited. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1513. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,  
SCHWABE, WILLIAMSON & WYATT, P.C.

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by:

  
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